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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,837	01/29/2004	Fritz Kirchhofer	33875/US	2958

7590 08/03/2006

DORSEY & WHITNEY LLP  
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Suite 1500  
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Minneapolis, MN 55402-1498

EXAMINER
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MACNEILL, ELIZABETH

ART UNIT	PAPER NUMBER
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3767

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/767,837

Applicant(s)

KIRCHHOFFER ET AL.

Examiner

Elizabeth R. MacNeill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/29/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The disclosure is objected to because of the following informalities: On page 11, the reference numeral #1 should be changed to #7 when referring to the counting and indicating means.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 1 recites the limitation "the delivery movement" in section .c). There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by SAMS (US #5,304,152).

Regarding claim 1, Sams teaches "An administering apparatus for administering a fluid product in doses, the administering apparatus comprising: a) a casing (#14) including a reservoir for the product; b) a driven device (66) for performing a delivery stroke in an advancing direction along a translational axis to deliver a product dosage; c) a drive device (23) for performing a delivery movement to deliver the product dosage; d) a dosage setting member (19) coupled to the driven device such that a rotational dosing movement, performed by the dosage setting member and the driven device about the translational axis, causes an axial translational dosing movement of the dosage setting member relative to the driven device and the casing (See Abstract); e) a translational stopper (#25) positioned opposite and axially facing the dosage setting member, in an axial end position of the dosage setting member; and f) a rotational block (Fig 5, #22) which, in the axial end position of the dosage setting member, permits the rotational dosing movement in a first rotational direction and blocks the rotational dosing movement in a second rotational direction (Col 5 ,line 53-end).

Regarding claim 2, a first rotational stopper (#73) (secured by the dosage setting member, #22) and second rotational stopper (#25) (secured by the casing) about (Fig 3c).

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Regarding claim 3, the first rotational stopper (#73) (secured by the dosage setting member) and second rotational stopper (#25) (secured by the drive device #23) abut (Fig 3c).

Regarding claim 4, the first rotational stopper (#73) (secured by the dosage setting member) and second rotational stopper (#25) (secured by the driven device #66) cannot be moved axially relative to the translational stopper when in the end position (See Col 5, lines 53-end).

Regarding claim 5, the first and second rotational stoppers abut against each other and protrude axially towards each other (See Figs 4A-5B).

Regarding claim 6, the first rotational stopper is a protrusion (#29) and the second rotational stopper is a recess (#28).

Regarding claim 7, the first and second rotational stoppers are formed on abutting areas which face each other axially (See figs 3A-3D).

Regarding claim 8, the first rotational stopper (#73) (secured by the dosage setting member) is formed as one piece and second rotational stopper (#25) (secured by the driven device #66) is formed as one piece.

Regarding claim 9, the dosage-setting member is threadably connected to the driven device (Col 5 line 39-46).

Regarding claim 10, the first and second rotational stoppers abut in pairs, spaced in the circumferential direction. (See Figs 4A-5B).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sams as applied to claim 1 above, and further in view of DiBIASI (US #6,146,361).

Regarding claims 11 and 12, Sams teaches the administering apparatus of claim 1, as well as a cannula (#13), but does not specify the dimensions of the cannula. DiBiasi teaches the use of a 31-gauge needle (See Abstract) in an injection device.

It would have been obvious to a person skilled in the art at the time of the invention to combine the 31-gauge needle of DiBiasi with the administering apparatus of Sams in order to reduce the pressure the needle exerts on the skin of the patient receiving the injection, as a result of the reduced diameter of DiBiasi's needle.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,899,698 (Sams), US 5,279,585 (Balkwill), US 6,221,046 (Burrroughs), 5,383,865 (Michel).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth R. MacNeill whose telephone number is (571)-272-9970. The examiner can normally be reached on 7:00-3:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ERM

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink that reads "Kevin C. Sirmons". The signature is written in a cursive, flowing style with a large initial "K".

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